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In the

Supreme Court of the United States

OCTOBER TERM, 1954

No. [redacted]113

JEOFFROY MFG., INC.,
Petitioner,

v.

WILLIAM T. GRAHAM,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT

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PETITION FOR WRIT OF CERTIORARI

To the Honorable Supreme Court of the United States:

Petitioner, JEOFFROY MFG., INC., respectfully shows:

A. OPINIONS OF THE COURTS BELOW

1. The District Court did not file a formal opinion. Its letter opinion appears at R. 18, 30.

2. The opinion of the Court of Appeals for the Fifth Circuit appears at R. 818, 828 and is reported 219 F. 2d 511, 517.

B. JURISDICTION

1. The judgment of the Court of Appeals is dated and was entered February 11, 1955 (R. 836).

2. The order denying Jeoffroy's petition for rehearing is dated March 9, 1955 (R. 842).

3. Section 1254, Title 28 of the United States Code confers on this Court jurisdiction to review the judgment in question by writ of certiorari.

C. QUESTIONS PRESENTED FOR REVIEW

1. Did the Court of Appeals err in setting aside the finding of the District Court that patent No. 2,627,798 is void for lack of invention?

2. Did the Court of Appeals apply an appropriate standard of invention in reversing the judgment of the District Court holding Graham's improvement patent No. 2,627,798 void for lack of invention?

3. Did the Court of Appeals err in directing that judgment be entered holding patent No. 2,627,798 valid when there were contested issues upon which the District Court had not passed, i.e., whether Graham was the sole and original inventor and, if he was, whether he had used due diligence in reducing the invention to practice before same was fully made and disclosed by others?

D. STATUTES AND RULES INVOLVED

Title 35 U. S. C.

§101.—Inventions patentable.

Whoever invents or discovers any new and useful process, machine, manufacture or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

§102. Conditions for patentability; novelty and loss of right to patent.

A person shall be entitled to a patent unless—

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent, or

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, or

(c) he has abandoned the invention, or

(d) the invention was first patented or caused to be patented by the applicant or his legal representatives or assigns in a foreign country prior to the date of the application for patent in this country on an application filed more than twelve months before the filing of the application in the United States, or

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or

(f) he did not himself invent the subject matter sought to be patented, or

(g) before the applicant's invention thereof the invention was made in this country by another who had not abandoned, suppressed, or concealed it. In determining priority of invention there shall be considered not only the respective dates of conception and reduction to practice of the invention, but also the reasonable diligence of one who was first to conceive and last to reduce to practice, from a time prior to conception by the other.

§103. Conditions for patentability; non-obvious subject matter.

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Federal Rules of Civil Procedure

Rule 52. Findings by the Court.

(a) Effect. In all actions tried upon the facts without a jury or with an advisory jury, the court shall find the facts specially and state separately its conclusion of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the

findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41 (b).

E. STATEMENT OF THE CASE

This suit was filed by Jeoffroy on May 15, 1952 (R. 1) for declaratory judgment to determine a charge of infringement under Graham patent No. 2,493,811, entitled "Vibrating Plow and Mounting Therefor" (R. 764). Subsequently on February 10, 1953, patent No. 2,627,798, entitled "Clamp for Vibrating Shank Plows" (R. 749) was issued to Graham, and by his second amended counter claim he charged Jeoffroy with infringement thereof (R. 7). Jeoffroy's reply (R. 11) challenged validity of the patent.

Graham's first patent, No. 2,493,811, covers a spring clamp for attaching the shank of a ground working tool to the beam of a plow. It was held valid in *Jeoffroy Mfg. v. Graham, 206 F. 2d 772 (C. A. 5, 1953), cer. den. 347 U. S. 920.* His second patent, No. 2,627,798, covers an improved spring clamp of the same class. It consists of a fixed member attached to the plow frame and a movable member pivoted on the fixed member by means of a pivot pin located above the shank. The shank is inserted through a depending stirrup at the rear of the movable member and is bolted to the movable member at the forward end thereof. The shank is permitted to pivot and return to operating

position by means of a coil spring which is seated on the fixed part of the structure and imparts its spring pressure through a washer, nut and rod to the shank.

There were two basic defects in Graham's original patent structure, (1) a sliding and shifting pivot which produced wear at the rear of the bracket or fixed member, and (2) pulling load on the spring rod which produced wear on the rod and on the forward part of the bracket (R. 186-7, 285-6). Graham proposed to make a little better clamp by developing a better pivot and by taking some stress off the T-bolt and spring (R. 184). To effect these improvements he made three changes: (1) located the pivot pin and plate portion of the movable member above the shank; (2) bolted the plate and shank together by a separate bolt at the forward end; and (3) provided a stirrup to carry the shank at the rear (R. 222-4, 299-30, 302).

The state of the art was reflected by a group of prior patents (R. 651-93), the patents cited as references by the Patent Office (R. 757-80), and prior unpatented devices—Jeoffroy (R. 802-3), Ulmen (R. 694-5, 786-99), Holm (R. 781-85), Helfeld (R. 810-13), and McKee (R. 696)—which were discussed at length in the testimony and were additionally shown by actual devices and reconstructed models.

Jeoffroy's expert witness, Mr. Witherspoon, not a patent expert but a qualified mechanical engineer testifying for his first time in a patent case, testified as to the structure of the patent, segments of the prior art, the problems involved, various possible solutions of those problems, com-

parisons of the various structures, etc., and concluded that the improvements made by Graham were well within the expected skill and capacity of a workman skilled in the agricultural implement manufacturing art (R. 563-77). Graham's expert, Mr. Fenton, testified at length but did not contradict Mr. Witherspoon's testimony in this respect in any manner whatever.

Graham claimed a date of invention about March, 1950 (R. 183), and produced a drawing dated March 19, 1950 (R. 804), but his testimony at the previous trial in April, 1951 (R. 206-9), revealed that he then thought such a structure unworkable. During the course of that trial the Helfeld structure (R. 810-13) was fully disclosed and its workability demonstrated by Jeoffroy. Graham then made further drawings and filed his application for patent on August 27, 1951, but at the date of the trial in April, 1953, he had done nothing toward production except make one aluminum model (R. 116-7, 284-5, 605).

The District Court found that the improvements covered by the patent were well within the capacity of a skilled mechanic and held the patent void for lack of invention (R. 31). It did not decide whether Graham was the first and sole inventor or whether he used due diligence in reducing the invention to practice before same was made and disclosed by others.

The Court of Appeals for the Fifth Circuit disagreed with the District Court on the question of invention, reversed the judgment of invalidity, and disposed of all ques-

tions by directing that judgment be entered holding the patent valid and infringed. (R. 832-35), 219 F. 2d 518-20.

F. REASONS FOR THE ALLOWANCE OF THE WRIT

1. The decision of the Court of Appeals for the Fifth Circuit with respect to review of findings of fact by the District Court is in conflict with the express provisions of Rule 52 of the Federal Rules of Civil Procedure; is in conflict with the decisions of this Court upon that question in *United States v. United States Gypsum Co., 333 U. S. 364, 395, 92 L. Ed. 746, 766 (1948); Graver Tank & Mfg. Co. v. Linde Air Prod. Co., 336 U. S. 271, 274, 279, 93 L. Ed. 672, 676, 679 (1949); United States v. Yellow Cab Co., 338 U. S. 338, 94 L. Ed. 150 (1949);* and *United States v. Oregon State Medical Society, 343 U. S. 326, 332, 339, 96 L. Ed. 978, 984, 988 (1952);* and is in conflict with the decisions of other Courts of Appeal in the following cases: *B. F. Sturtevant Co. v. Massachusetts Hair and Felt Co., 122 F. 2d 900, 906-8 (C. A. 1, 1941); Trico Products Corp. v. Delman Corp., 180 F. 2d 529 (C. A. 8, 1950); Keuffel & Esser Co. v. Pickett and Eckel, 182 F. 2d 581 (C. A. 7, 1950); Jacuzzi Bros. v. Berkeley Pump Co., 191 F. 2d 632, 637 (C. A. 9, 1951); Wasserman v. Burgess & Blacher Co., 217 F. 2d 402 (C. A. 1, 1954).*

2. The approach to the question of invention and the standard applied by the Court of Appeals is contrary to the Patent Act of 1952, 35 U. S. C. §103, and is in conflict with the decisions of this Court in *Great Atlantic & Pacific*

Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1950), and *Altoona Publix Theatres v. American Tri-Ergon Corp., 294 U. S. 477, 79 L. Ed. 1005, 55 S. Ct. 455 (1935)*. In that respect it is also in conflict with the decisions of the First Circuit in *Wasserman v. Burgess & Blacher Co., 217 F. 2d 402 (1954)*; the Third Circuit in *Pennsylvania Crusher Co. v. Bethlehem Steel Co., 193 F. 2d 445 (1951)*, and *Packwood v. Briggs & Stratton Corp., 195 F. 2d 971 (1952)*; the Fourth Circuit in *Ingersoll-Rand Co. v. Black & Decker Mfg. Co., 192 F. 2d 270 (1951)*, *Kay Patent Corp. v. Martin Supply Co., 202 F. 2d 47 (1953)*, *Interstate Rubber Products Corp. v. Radiator Specialty Co., 214 F. 2d 546 (1954)*, and *Todd v. Sears-Roebuck and Company, 216 F. 2d 594 (1954)*; the Sixth Circuit in *United Specialities Co. v. Industrial Wire Cloth Products Corp., 186 F. 2d 426 (1951)*, *Whitman v. Andrus, 194 F. 2d 270 (1952)*, *General Motors Corp. v. Estate Stove Co., 201 F. 2d 645 (1953)*, *on rehearing 208 F. 2d 912 (1953)*, and *Buffalo-Springfield Roller Co. v. Galion Iron Works Mfg. Co., 215 F. 2d 686 (1954)*; the Seventh Circuit in *Skoog v. McCrary Refrigerator Co., 211 F. 2d 254 (1954)*; the Eighth Circuit in *General Bronze Corp. v. Cupples Products Corp., 189 F. 2d 154 (1951)*, and *Continental Farm Equipment Co. v. Love Tractor, 199 F. 2d 202 (1952)*; the Ninth Circuit in *Photocraft v. Photopatrol, 189 F. 2d 625 (1951)*, *Jacuzzi Bros. v. Berkeley Pump Co., 191 F. 2d 632 (1951)*, and *Kwikset Locks v. Hillgren, 210 F. 2d 483 (1954)*; and the Tenth

Circuit in *Hutchinson Mfg. Co. v. Mayrath, 192 F. 2d 110 (1951)*, and *Kobe v. Dempsey Pump Co., 198 F. 2d 416 (1952)*.

3. The Court of Appeals has so far departed from the accepted and usual course of judicial proceedings in determining material fact questions at issue and not determined by the District Court that this Court should exercise its power of supervision.

G. ARGUMENT AMPLIFYING REASONS

1. We respectfully submit that the decision of the Court of Appeals in setting aside the District Court's finding of lack of invention is a complete disregard of Rule 52 of the Federal Rules of Civil Procedure. That rule provides that the finding of fact of the trial court shall not be overturned unless clearly erroneous and that due regard shall be given to the opportunity of the trial court to judge the credibility of the witnesses. This Court settled the law in *United States v. United States Gypsum Co., 333 U. S. 364, 395*, as follows:

> "A finding is 'clearly erroneous' when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has been committed."

And in *United States v. Yellow Cab Co., 338 U. S. 338*, and *United States v. Oregon State Medical Society, 343 U. S. 326*, you added that the reviewing court will not try the case de novo on the record. In the *Yellow Cab* case at page 342 it was specifically held that,

> "* * * a choice between two permissible views of the weight of evidence is not 'clearly erroneous'."

Further in *Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U. S. 271*, you said that in no type of case is it more appropriate to give due regard to the trial court's opportunity to judge credibility of the witnesses than in a patent case where the evidence is largely the testimony of experts, and at page 279 that

> "The same deference is due to the findings of the trial court which overturn claims as to those which sustain them."

We respectfully urge that the Court of Appeals in the case at bar has violated all of these rules.

First, it did not conclude that the District Court's finding was clearly wrong; it did not say it was convinced a mistake had been made; it merely said it was compelled to "*disagree* with the learned District Court's conclusion that the 798 patent is invalid * * * for * * * lack of invention." (R. 832, 219 F. 2d 518.)

Second, the opinion shows upon its face that the Court of Appeals sought to try the case de novo upon the record.

Third, it classified the case as *close* (Footnote 17, R. 833, 219 F. 2d 519), thus expressly recognizing that there were two permissible views as to the weight of evidence, yet it set aside the view selected by the District Court.

Fourth, it usurped the District Court's function of determining the credibility of witness and disregarded the tes-

timony of Jeoffroy's expert witness *because he was only a qualified engineer and not a professional patent testifier.*

Surely the point here involved is one of great concern to all litigants in the Federal Courts, and this Court should exercise its powers of review to set the Fifth Circuit upon a straight course and remove this derelict decision from the otherwise calm seas of appellate review of trial court findings.

2. Of equal importance is the need for review of the obviously improper approach to and standard of invention applied by the Court of Appeals.

The question of invention here is controlled by the Patent Act of 1952, Title 35 U. S. C., and particularly Section 103 thereof which provides that a patent may NOT be obtained if the subject matter as a whole at the time the invention was made would have been obvious to a person having ordinary skill in the art to which the subject matter pertains. This Court has not yet passed upon that section of the statute, but it obviously is merely a codification of existing law, and several of the Courts of Appeal have so held. *Stanley Works v. Rockwell Mfg. Co., 203 F. 2d 846 (C. A. 3, 1953); General Motors Corp. v. Estate Stove Co., 203 F. 2d 912 (C. A. 6, 1953); Interstate Rubber Products Corp. v. Radiator Specialty Co., 214 F. 2d 546 (C. A. 4, 1954); Wasserman v. Burgess & Blacher Co., 217 F. 2d (C. A. 1, 1954).* The approach is whether the art as a whole as it existed at the time of the alleged invention was such that the advance made would have been obvious to one

possessing ordinary skill in the art. This was precisely the approach used in *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127 (1950)*, and applied in all of the Court of Appeals decisions supra, pp. 8, 9.

But the Court of Appeals for the Fifth Circuit, in accord with its own prior decisions, followed the old approach of *Parks v. Booth, 102 U. S. 96, 104, 26 L. Ed. 54, 57 (1880)*, that novelty and invention in a combination patent cannot be negatived by the prior art unless the combination is disclosed by a single prior art reference. In other words the Fifth Circuit held that invention cannot be negatived by reference to various segments of the prior art for disclosure of the subject matter of the alleged invention as a whole. That holding is squarely against the statute and the *A. & P.* decision. While *Parks v. Booth* may survive as to the distinct questions of novelty and anticipation it clearly is not the law as to invention, but the Fifth Circuit fails to recognize the change.

Aside from the approach, the standard applied is wrong. The Court of Appeals clings to its own old rule that

> "An improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where as here, it produces an old result in a cheaper and otherwise more advantageous way." (R. 832-3, 219 F. 2d 519.)

Its standard is improved economy, efficiency, and other advantages, a faulty standard which was squarely condemned

in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, *294 U. S. 477, 486* in this language:

> "The patentees brought together old elements, in a mechanism involving no new principle, to produce an old result, greater uniformity of motion. However skillfully this was done, and even though there was produced a machine of greater precision and a higher degree of motion-constancy, and hence one more useful in the art, it was still the product of skill, not of invention."

It was even more positively condemned in the *A. & P.* case when this Court held that the combination must in some way exceed the sum of the parts, that there must be some unusual or surprising consequence from the unification of elements, that there must be a change of respective functions of the elements brought about by the combination before there is any invention. The Court of Appeals for the Fifth Circuit obviously failed to heed the *A. & P.* caution that

> "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements."

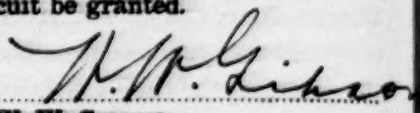
and we earnestly urge that it wholly disregarded the standard provided by the statute and announced by this Court.

Without detail we also submit that the approach used and the standard applied is out of tune with every single one of the decisions from other Circuits which we have cited supra, pp. 8, 9, 10.

The District Court applied a correct standard and found the patent wanting. We submit that this Court should exercise its powers of review here not only to reinstate the District Court's judgment and do justice in this case but to eliminate the erroneous decision of the Court of Appeals from the pages of patent jurisprudence and bring the Fifth Circuit into conformity with the statute, the decisions of this Court and the decisions of the other Circuits.

3. The third ground alone is sufficient for this Court to exercise its reviewing power. The District Court concluded that the patent was void for lack of invention and therefore did not decide whether Graham was the sole and original inventor, or, if so, whether he had exercised reasonable diligence in reducing the concept to practice before same was made and fully disclosed by others. These material issues were seriously contested and we believe the evidence shows that Graham was not the original inventor and that he did not use due diligence in reducing to practice. But in any case the weight of that evidence was for the District Court. Nevertheless the Court of Appeals in directing that a judgment of validity be entered necessarily determined those questions. It tried those issues de novo on the record and clearly usurped the Trial Court's function. The usual and customary practice is to remand the case to the trial court for disposition of material fact questions not previously decided, and the Court of Appeals has so far departed from that practice as to call for an exercise of this Court's supervision.

WHEREFORE, Petitioner prays that this petition for writ of certiorari to review the judgment of the Court of Appeals for the Fifth Circuit be granted.



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APPENDIX TO PETITION FOR WRIT OF CERTIORARI

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APPENDIX

In the

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FOR THE FIFTH CIRCUIT

No. 15117

JEOFFROY MFG., INC.,

Appellant,

v.

WILLIAM T. GRAHAM,

Appellee,

AND

WILLIAM T. GRAHAM,

Appellant,

v.

JEOFFROY MFG., INC.,

Appellee.

Appeals from the United States District Court for the Northern District of Texas

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(February 11, 1955.)

Before HUTCHESON, Chief Judge, RIVES, Circuit Judge, and DAWKINS, District Judge.

RIVES, Circuit Judge: This suit was filed by Jeoffroy Mfg., Inc. on May 15, 1952, for declaratory judgment to

determine whether a spring trip device used on its commercially manufactured plow infringes United States Patent No. 2,493,811, issued on January 10, 1950 as "Vibrating Plow and Mounting Therefor," and owned by William T. Graham.[1]

By counterclaim, Graham charged Jeoffroy with infringement of its aforementioned patent, No. 2,493,811, and also with infringement of its United States Patent No. 2,627,798, issued February 10, 1953, and entitled "Clamp for Vibrating Shank Plows."

On a prior appeal involving the same parties and Graham's No. 2,493,811 patent, this Court affirmed with immaterial modification the judgment of the district court holding that patent valid and infringed by a device formerly manufactured and sold by Jeoffroy. See *Jeoffroy Mfg., Inc. v. Graham, 206 F. 2d 772, cert. den. 347 U. S. 920.*

The district court held patent No. 2,493,811 valid and infringed, and further held patent No. 2,627,798 invalid for lack of invention.[2] Jeoffroy has appealed only from

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[1]Both the corporate appellant, Jeoffroy Mfg., Inc., and the individual appellee, William T. Graham, are located at Amarillo, Texas, where they are competitively engaged in the manufacture and sale of commercial plows. To avoid confusion in referring to the parties in the two consolidated appeals, they will hereinafter be called Jeoffroy and Graham, respectively.

[2]The district court's opinion is succinctly set forth in two letters to counsel for the respective parties, which were filed of record but are not officially reported. The most pertinent portions of those letters read as follows:

"Patent No. 2,493,811

"The Graham Patent 811 may rank as a pioneer patent within the sense of some strong cases, including a number of combination patents, but I lean to the opinion that it is ruled rather by the teaching of other leading cases, and embodies a meritorious, yet not an outright pioneer,

(Footnote continued on p. 3.)

that portion of the judgment holding the former Graham Patent infringed, while Graham has appealed from the holding as to invalidity of his later improvement patent

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invention. Even if it is only a meritorious invention, being of proven worth, the patentee is entitled to claim a substantial range of equivalents, consistently with the context of the patent, the Patent Office history and the prior art and use. * * *

"The said Graham patent has already been adjudged valid by this Court in an earlier case, and in that previous trial the prior art was examined in reference to the validity of the patent. The inquiry is not being retraced from that standpoint at the present time, but has been noticed as it bears on the scope of claims and proper range of equivalents under the said patent. * * *

"Next in order is the question of infringement. The Graham patent, claim 5, in the element of a shank between the fixed member and the moveable member of the bracket and in moveable engagement with the said parts will not read on the accused Jeoffroy device. The argument on the point of position that the stirrup and the yoke in the Jeoffroy structure suffice to put the shank between a part of the moveable member and the fixed member of the Graham construction is too far fetched. * * * Likewise the correlated claim language 'in moveable engagement with the said parts' probably will not read on the accused Jeoffroy structure. * * *

"The fact that the Graham patent, claim 5, cannot be read literally on the accused device is not at all conclusive against infringement. The doctrine of equivalents must be reckoned with, and most often comes into play with apparatus or mechanical inventions. * * * True in the accused device the shank is placed below the moveable member of the bracket, unlike the patent arrangement above said moveable member, but that is simply a reversal of position, and the Courts speak with one voice in saying that mere transportation of members in a combination structure, where there is no actual change of function, is just an equivalent and fails to avoid infringement. * * *

"The accused structure has simply supplanted the dual function of the spring bolt in the patented structure by the expedient of a new element, and with that change cessation of longitudinal motion of the shank follows. The mere elimination of virtually all of that particular motion, which was not indispensable anyway to the principle of the invention claimed in the Graham patent, results incidentally from an example of using two elements to do what was done before by a double duty element and such an alteration will not avoid infringement of the patent. * * *

"* * * my conclusion (is) that the Graham patent, as aided by the doctrine of equivalents, is infringed in claims 5 and 6 by the Jeoffroy structure.

"Patent No. 2,627,798

"The recent Graham structure covered in the above numbered patent, issued in 1953, is a plain counterpart of the accused structure made by Jeoffroy. The same reasons for finding infringement against Jeoffroy, also disclose invalidity of this latest Graham patent. It is a case of double patenting between the two Graham patents, and so under the ban of a well settled rule of patent law. If the said patent were not invalid as a double patent, in any event it would be for lack of invention. This

(Footnote continued on p. 4.)

for lack of invention. In view of this Court's decision on the prior appeal, no issue is presented as to the validity of patent No. 2,493,811, the basic question confronting us for determination being whether that patent is infringed by the accused device now manufactured and sold by Jeoffroy. However, Jeoffroy does defensively assert the alleged invalidity of Graham's improvement patent No. 2,627,798, both as anticipated in fact by the prior art and invalid in law for lack of invention, though it frankly concedes

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patent 798 does mark an improvement bettering efficiency and economy over patent 811, but that is not enough to constitute invention. The said patent 811 was the spring board and from that vantage background the next step from that structure to the structure of patent 798, was well within the capacity of a skilled mechanic.

"Counsel will submit a decree on the cross action as to the infringement of patent 811, and adjudging patent 798 invalid * * *."

The above quotations are from the Court's letter opinion, dated September 9, 1953, announcing its original decision. In overruling Jeoffroy's motion for rehearing, it further amplified its prior letter opinion as follows:

"Plaintiff's counsel * * * insist that the shank in the latest Jeoffroy bracket, by being bolted towards the front end of the movable fulcrum plate, is, in effect, hinged directly to the plow frame. Thus it is likened to the operation of the prior art in contrast to that of Patent No. 811. It is difficult for me to see how such claim is much better for this last Jeoffroy type than in the earlier litigation. Of course, the nib and socket pattern in that earlier type did not hold the shank and the fulcrum plate together so rigidly as can be done by the nut and bolt in the present type, but I think the difference inconsequential from the standpoint of the present inquiry. In my opinion, consistency is lost in any theory that the prior art was insufficient to shelter the earlier Jeoffroy type, but is sufficient to shelter the latest Jeoffroy type. * * *

"* * * The argument in support of the motion before the Court stresses the contention that the modes of operation are entirely different in the Graham structure and the Jeoffroy structure. The gist of it is that the Graham structure features a shank nested between a movable and a fixed member of the bracket and without any rigid attachment, while the Jeoffroy structure uses a shank tightly bolted to the movable member of the bracket, like its alleged prototypes in the mechanical art and that by such assembly it is, in effect, hinged directly on a fixed member of the bracket or plow frame. I am unable to agree with that position. In my opinion, the shank mounted in the way stated retains tangibly more useful motion and vibration than would be true if it were actually attached rigidly to a fixed member. * * *

"* * * the only essentials, as I see, are a finding of infringement of Patent No. 811 and invalidity of Patent No. 798, together with the conclusion that defendant is entitled to injunctive relief, but reserving the question of damages for future determination. * * *."

infringement of that patent by its new structure if the patent is valid.

I. Issue of infringement of Patent No. 2,493,811.

We think the basic structure, mode of operation and purpose of Patent No. 2,493,811, hereinafter simply referred to as the Graham 811 patent, is adequately set forth in our former decision and need not be restated here. *Jeoffroy Mfg. v. Graham*, supra, at pp. 773-774. Only claims 5 and 6 of this patent are here involved.[3] Our inquiry on this infringement issued is further narrowed to a consideration of the specific language of claim 5, in view of Jeoffroy's admission that, while the bracket of its accused device exhibits some divergence in structure from the channel shaped formation of claim 6, it must nevertheless be conceded "that if we infringe Claim 5 we likewise infringe Claim 6."

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[3]These two claims in issue of Graham's 811 patent read as follows:

"5. In a plow having a frame and a ground working tool provided with a shank adapted to rock relatively to the frame when the plow is in operation in a forward direction, a mounting for attaching and supporting the shank of the ground working tool from the frame including a clamp fixedly attached to the frame, the clamp including a part that is fixed to the frame and another part pivotally mounted on the fixed part, the shank having an end portion thereof between said parts and in movable engagement with the said parts, a coil spring having one end thereof in engagement with one of said parts, means at the other end of the spring connected with the other of said parts to maintain the spring in position and for holding the said parts of the clamp with the end portion of the shank therebetween in their resiliently held-together association so that when the shank is rocked or moved the end portion of the shank between the parts will cause the movable part of the clamp to move away from the fixed part along with said end portion and back to normal position with the end portion of the shank contactingly held between the two parts, and means on one of the parts engageable with a part of the end portion of the shank to prevent disengagement of the shank from the clamp but to allow same to rock.

"6. In a device as claimed in and by claim 5, wherein the fixed part of the clamp is of channel shape formation and the said end portion of the shank is disposed therein and prevented from moving laterally."

We think the district court properly held that claim 5 could not be read in express terms upon the new Jeoffroy structure, since the Jeoffroy shank is not "between the fixed member and the moveable member of the bracket and in moveable engagement with the said parts." (See footnote 2, supra.) Like the district court, we reject as "too far fetched" Graham's insistence that the position of the Jeoffroy stirrup and yoke below the shank sufficiently locates the shank between at least a part of the movable member and fixed member so as to satisfy the literal language of the claim. Graham's insistence in this respect, like his further contention that the Jeoffroy structure meets the call of claim 5 for a shank "in movable engagement with the said parts" because of the looseness in the bolt fitting which connects the yoke, shank, and hinge and the small amount of play at the forward end of the shank between the stirrup and yoke, seems to us to stretch the express wording of claim 5 beyond the fair intendment of the language used in order to cover a substantially divergent structure. Irrespective, however, of our adoption of the district court's conclusion that no infringement exists in express terms, there nevertheless remains for our consideration the question of whether the trial court justifiably held claims 5 and 6 of Graham's 811 patent infringed under a broad application of the doctrine of equivalents.

We agree with the district court's statement that Graham's 811 patent "embodies a meritorius, yet not an outright pioneer invention," and that it is entitled to a

range of equivalents consistent "with the context of the patent, the Patent Office history and the prior art and use." (Footnote 2, supra.) For reasons hereinafter stated, however, we disagree with its conclusion that the doctrine of equivalents should be broadly applied in this instance so as to bring the new Jeoffroy structure within the condemnation of Claims 5 and 6.

If the litigation involving this patent were of first impression, we might appropriately concede that Graham's protection thereunder ought not be confined to the type structure disclosed by the patent claims and specifications. Under such circumstances, the trial court's finding of a mere transposition of members in the accused structure, with "no actual change of function," might be sufficient to warrant its finding of equivalence. *Graver Mfg. Co. v. Linde Co., 339 U. S. 605, 609.* However, we think the prior course of this litigation, in the Patent Office and in this Court, justly requires such limitation of the scope of the Graham 811 claims in issue as would necessarily prevent Graham from successfully urging infringement by the new Jeoffroy device.

In the former suit involving the old infringing Jeoffroy structure *(Jeoffroy Mfg., Inc. v. Graham,* supra), in order to distinguish the inventive concept embodied in his 811 patent from the prior art, Graham repeatedly and successfully urged upon the district court and this Court that his patent was not anticipated by a structure in which the

shank is either directly pivoted on a fixed member,[4] or is attached to a hinge member that is directly pivoted on the fixed member, yet he now contends that the new Jeoffroy structure, which we think embodies substantially the type attachment there distinguished by him, infringes this same patent. Moreover, Graham also testified in both the former and present suits that longitudinal motion of the shank relative to the hinge member was at least an important part of his invention,[5] yet he now urges that the absence of such motion in Jeoffroy's new structure is practically immaterial and insufficient to avoid infringement.[6] Furthermore, in filing application for his improvement patent, No. 2,627,798, with the Patent Office, which patent, if valid, both parties agree is infringed by the practically identical new Jeoffroy device, Graham contended that his

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[4]For example, in his brief on the former appeal, Graham made the following argument as to validity of his 811 patent, the substance of which was adopted by this Court in its opinion:

"Prior art patents relied on by Defendants have not contributed anything to this art and particularly the art of resiliently and frictionally holding the shank of a ground working tool between a fixed part and a movable part, i.e., the bracket on the H-beam and the fulcrum plate pivotally mounted on the bracket. Graham was the first to produce a device which successfully provided for mounting of a ground working tool shank that would rock and yet not have the shank hinged directly on a fixed member, this new structure providing an action of the ground working tool never before accomplished, and an entirely different distribution of forces which was not possible in prior devices."

[5]Graham's testimony in the present suit on this issue reads as follows:

"Q. Do you consider longitudinal movement between the fulcrum member and the shank—or to put it another way—longitudinal movement of the shank relative to the fulcrum member in your patented structure as shown in your old patent 2,493,811 to be an important feature of that patent?

"A. Yes, I think it's rather important.

"Q. Do you consider that as a part of the invention, the alleged invention, Mr. Graham?

"A. Yes, I think so."

[6]See Paragraph 5 of trial court's findings, footnote (2), supra.

shank was "rigidly secured" to the hinge member,[7] yet he now asserts in order to sustain his present charge of infringement that the new Jeoffroy device, its structural twin and counterpart, is "in movable engagement" with the hinge member. Similarly, in prosecuting his new 2,627,798 patent application before the Patent Office he successfully urged, in effect, that patentable novelty and invention existed therein over his old 811 patent because, among other features, his different method of attaching the shank in his improvement patent, i.e. its location beneath the hinge member and rigid attachment thereto, resulted in a different mode of operation and distribution of stresses from that which had precipitated an inordinate amount of wear in the old sliding pivot and fulcrum assembly of his 811 patent,[8] yet he now contends that the new Jeoffroy structure, which concededly duplicates the struc-

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[7]The file wrapper of Graham's new patent, No. 2,627,798, reveals that Graham there represented one of the objects of his alleged invention was "to provide a mounting which includes a fixed part and a movable part pivotally connected with the fixed part and having a shank attaching portion to which the shank is *rigidly secured* and resiliently retained on the fixed part." (Emphasis supplied.)

[8]For example, in response to the Patent Examiner's original rejection of all of the claims of his improvement patent as anticipated by his old 811 patent Graham's counsel argued as follows:

"At the first of the interviews the Examiner's rejection of the claims on applicant's patent was discussed. It was pointed out that the present construction is an improvement over the structure disclosed in applicant's (811) patent. The patented structure has proved a highly commercial success and has made this type of plow satisfactory for substantially all plowing conditions. It was found, however, that wear occurred between the shank and the fixed part of the clamp where the fulcrum shifted from the pin to that portion of the fixed part of the clamp directly at the rear end of the clamping face thereof. It was pointed out that the present construction avoided this wear by inserting the movable part between the plowing shank and the fixed part and by locating the pivot to avoid rubbing contact of the pivoted part with the fixed part of the clamp. With this arrangement the vibratory movement of the shank acted on the pivoted part or shank attaching member of the clamp. This shifting of the wear point to the pivoted part facilitates repair and replacement when wear does occur."

ture of his new patent, nevertheless retains that same degree of flexibility and method of operation of his old 811 patented structure as now fairly entitles him to prevail on the issue of infringement.[9]

Graham argues, in substance, that the claimed inconsistencies in his various positions before the Patent Office, the district court and this Court, are more illusory than real; that in defensively asserting these alleged inconsistencies Jeoffroy is seeking to avoid infringement on a new theory and technical basis by quoting prior statements and arguments in other independent and materially unrelated proceedings out of context, and either according them a binding effect never intended, or interpreting the claimed structural and operational differences between Graham's 811 patent and the teachings of the prior art then relied upon as conclusive against infringement here, when at most the previously asserted distinguishing features were merely some among many which could have been urged to avoid anticipation and establish validity; that, in any event, the omission of these elements in the accused device is insufficient to avoid infringement under the applicable range of equivalents. In view of these insistencies, we have re-examined Graham's arguments on the former appeal, as compared with those now urged by him, but we cannot agree that they are immaterial to his present charge of infringement, or that they do not effectively nullify the

[9]The trial court apparently had no opportunity in its original decision to consider from this Court's viewpoint the effect of Graham's inconsistent positions as limiting the scope of his 811 claims, since its original letter decision was rendered on the same day as this Court's decision on the former appeal, i.e. September 9, 1953.

force which might otherwise flow from the trial court's finding and his argument that the new Jeoffroy device exemplifies a mere colorable departure in structure and method of operation from his 811 patent which is insufficient to avoid infringement. (Footnote 2, supra.) While we expressly disavow any intimation of actionable bad faith on the part of the patentee, Graham, in assuming positions for the purpose of avoiding anticipation and establishing validity of both his 811 and improvement patent, which appear to us inconsistent with positions now assumed for the purpose of prevailing on the present issue of infringement, we do hold, contrary to, but in the language of the district court, that "the context of the patent, the Patent Office history and the prior art and use" fairly limit and restrict the scope of Graham's monopoly under 811 to a structure wherein the shank is mounted between a fixed part and a movable part, in "movable engagement" with each of said parts, and clampingly held thereby; that the prior art, the physical exhibits, the testimony, and this Court's decision on the former appeal,[10] viewed as a whole, fairly establish that the new Jeoffroy structure may not logically be viewed as embracing the essential elements of the 811 patent claims, either literally or by equivalence,

[10]While it is true that this Court, in its decision on the former appeal, did not expressly restrict the scope of Graham's 811 claims to the precise structure disclosed by the patent, we think the opinion itself fairly evidences this Court's acceptance of Graham's repeated arguments that the essentially novel concept of that invention was "the idea of resilient and frictional engagement of the shank of a ground working tool between a fixed part and a movable part," etc. (see 206 F. 2d 777), and that he may not now extend the scope of his 811 monopoly to embrace the substantially different Jeoffroy structure here claimed to infringe.

and that the trial court's finding of infringement of claims 5 and 6 of the Graham 811 patent may not therefore be sustained. *Cf. Livesay Industries v. Livesay Window Co., 5 Cir., 202 F. 2d 378, 382.* See *Graver Mfg. Co. v. Linde Co., 339 U. S. 605, 609; Westinghouse v. Boyden Power Brake Co., 170 U. S. 537, 568; Jungersen v. Baden, 2nd Cir., 166 F. 2d 807, 809; Wood v. Peerless Motor Car Corp., 6th Cir., 75 F. 2d 554, 555; Southern States Equip. Corp. v. USCO Power Equip. Corp., 5th Cir., 209 F. 2d 111, 120; Stewart-Warner Corp. v. Lone Star Gas Co., 5th Cir., 195 F. 2d 645, 648; Independent Pneumatic Tool Co. v. Chicago Pneumatic Tool Co., 7th Cir., 194 F. 2d 945, 947; Chicago Forging & Mfg. Co. v. Bade-Cummins Mfg. Co., 6th Cir., 63 F. 2d 928, 929-930.*

II. Validity of Graham's Improvement Patent, No. 2,627,798.

The application for Graham Patent No. 2,627,798, hereinafter simply called 798, was filed on August 27, 1951, and the patent issued February 10, 1953. It relates to an improvement of the original structure revealed by Graham's old 811 patent. While it is basically akin to the structure thereby disclosed and described in our former decision *(Jeoffroy Mfg., Inc. v. Graham,* supra, at pp. 773-774), it does exhibit distinguishing structural features in that the pivot pin and fulcrum plate have been relocated above the shank, instead of below the shank as in Graham's old 811 patent, and the fulcrum plate has a stirrup device which supports the shank at a point adjacent the pivot pin.

The 798 patented structure also operates on a fixed, rotating pivot instead of the loose, sliding pivot of the old Graham 811 device.

Jeoffroy concedes that Graham's new 798 patent exhibits a divergent structure in the following particulars: (1) the location of the pivot pin above the shank; (2) the short bolt which attaches the shank and shank attaching member to each other at the forward ends thereof; (3) the rearward extending lugs on the fixed member and the upward extending lug on the hinge member, through which the pivot pin is inserted to form the pivot; and (4) the downward extending loop or stirrup which embraces the shank at the rear of the shank attaching member. According to Jeoffroy, the sum of the above changes constitutes no more than a manufacturer's modification made for the purpose of reducing operational stress and wear in the basic 811 patent structure, which the trial court correctly viewed as "within the capacity of a skilled mechanic," and therefore lacking in invention.

On the other hand, Graham contends that, while his 798 patent uses "the basic idea of the fulcrum plate and the movable engagement of the shank," it in effect produces an old result in a more advantageous way by substituting the fixed and rotating pivot, to some extent revealed by prior art devices, for the wear-producing, sliding and shifting pivot of 811, at the same time retaining by means of its particular shank and pivot arrangement substantially that same degree of flexibility and resiliency which

was such an advantageous feature of its 811 predecessor; that claims 1 and 2 of 798[11] are not invalid for "double patenting" and lack of invention, as held by the district court, but "clearly specify a particular arrangement and relationship of the parts that is not found in the Graham (811) Patent,"[12] as evidenced by issuance of 798 by the Patent Office after 811 was distinguished as a prior reference; that the claims of 798 further cannot be read upon the structure of 811 either literally or by equivalence; that 798 actually reveals a valid combination and patentable improvement over 811 and the most pertinent other prior art and use,[13] which was beyond conception by an ordinary artisan in the agricultural implement trade; finally, since infringement is admitted, Graham is clearly entitled to the injunctive relief and accounting prayed for.

With commendable candor Jeoffroy further concedes that "its accused structure cannot be distinguished in any material respect from Patent No. 2,627,798"; that "the Trial Court was clearly wrong in concluding that patent No. 2,627,798 is void as double patenting of the original

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[11]We think these two detailed and lengthy claims of Graham's 798 patent, the only ones granted by the Patent Office, need not be set forth in haec verba here. Generally, they are directed to the same type improved clamp structure and shank arrangement exhibited by the new Jeoffroy device, though specifically they recite means for maintaining the shank in "constant and continuous contact" with the shank attaching member.

[12]Compare this argument with Graham's argument on the infringement issue that his 798 patent's twin and counterpart, the new Jeoffroy device, is a structure substantially equivalent to that disclosed by his 811 patent.

[13]A number of the prior art patents and uses principally relied upon as anticipatory of Graham's 798 patent are the same as those previously cited by Jeoffroy in his unsuccessful attempt to upset the validity of 811 on the former appeal (see 206 F. 2d at p. 776), and will not be specifically reviewed in this opinion.

Graham invention,";[14] that no "single prior reference patent or structure anticipates completely the claims of patent No. 2,627,798" and "the claims will not read on any one of the references because there are specific differences of structure and of function"; and that "unquestionably Graham's new patent structure is a definite improvement over the old." However, on the issue of anticipation, Jeoffroy does insist that the prior art "as a whole" contains "the storehouse of information from which any skilled workman could draw to effect the changes made by Graham," particularly since a number of the improvements adopted were separately indicated by various prior art devices such as Lamprell, Erdman, Drader, Traeger, Dunbar, Carter, Moore, the Danish patent to Petersen, and the Valley City and supposed Helfeld and McKee prior use devices. See and *cf. Parks v. Booth, 102 U. S. 96, 104*, cited with approval in *Jeoffroy Mfg., Inc. v. Graham*, supra, at p. 777. On the issue of claimed invalidity, vel non for lack of invention, Jeoffroy relies mainly on the Supreme Court's landmark decision in *Great A. & P. Tea Co. v. Supermarket Equipment Corp., 340 U. S. 147*, apparently the favorite sanctuary of alleged mechanical patent infringers, and vigorously insists that the stricter test of invention there enunciated and adhered to by former decisions of this Court is not met by Graham's 798 patent. See *Ritchie*

[14] Apparently, consistency and logic compels Jeoffroy's admission in brief that, if the trial court was wrong in its factual finding of equivalence between its new structure and Graham's 811 patent, which he asserts and we have held that it was, then Graham's 798 patent cannot logically be viewed as invalid for "double patenting."

v. Lewis Browning Mfg. Co., 5th Cir., 196 F. 2d 434, 437; Graham v. Jeoffroy Mfg., Inc., 5th Cir., 206 F. 2d 769, 771-772; Robinson v. Di Gaetano, 5th Cir., 212 F. 2d 1, 3.

Our interpretation of the prior art, the physical exhibits, and the testimony, however, compels us to disagree with the learned district court's conclusion that the 798 patent is invalid, either for "double patenting" or lack of invention. Though we do agree that 798, as an improvement combination, is not entitled to any broad degree of protection over 811, it still seems to us that its hybrid type structure combining the wear-resisting rotating pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old 811 structure, reveals sufficient indicia of novelty and invention to justify limited protection. See *Southern States Equip. Corp. v. USCO Power Equip. Corp.*, supra, at p. 118. Other factors strongly influencing and, we think, reinforcing our conclusion as to the validity of 798 are: (1) that presumption of validity which attends the grant of a patent by the Patent Office where, as here, it appears to have fully considered and distinguished the very prior art patents here principally relied upon as anticipation *(Southern States Equip. Corp. v. USCO Power Equip. Corp.*, supra); (2) the rule that the burden of proof of invalidity is on the party seeking to upset a patent's prima facie validity from issuance, and that any reasonable doubt will be resolved against

him,[15] (3) the further rule, long recognized by this Court, that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art, where, as here, it produces an old result in a cheaper and otherwise more advantageous way;[16] (4) the trial court's findings and Jeoffroy's significant admissions, heretofore quoted, as to the improved efficiency and economy in the 798 structure, as well as the lack of disclosure thereof by any single device or group of devices in the prior art; (5) the fact that Jeoffroy himself apparently considered the 798 structure independently patentable over 811 and the prior art, as evidenced by his filing of an application for a patent on its counterpart and subsequent withdrawal thereof only when Graham's 798 patent was issued first; and (6) finally, the fact that the force which might otherwise attach to the eminent trial court's conclusion as to invalidity, insofar as based on testimony by Jeoffroy's witness, Witherspoon, that in his opinion the improvements embodied in 798 were within the capacity of an ordinary skilled mechanic, seems to us considerably weakened by the fact that this witness was admittedly not a patent expert, but only an engineer testifying for his first time in a patent suit.[17] We conclude, therefore, that

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[15]See Title 35 U. S. C. A. Sec. 282; Mumm v. Decker & Sons, 301 U. S. 168, 171, 81 L. Ed. 983, 985; Radio Corp. v. Radio Engineering Lab., Inc., 293 U. S. 1, 7, 8, 79 L. Ed. 163; Hughes Tool Co. v. Robertson Rock Bit Co., Inc., 80 F. Supp. 809 (Aff. 176 F. 2d 783, 5th Cir.).

[16]Robertson Rock Bit Co. v. Hughes Tool Co., 5th Cir., 176 F. 2d 783, 790, 791; Troup, et al. v. Cox, 5th Cir., 133 F. 2d 82; O. K. Jelks & Son v. Tom Huston Peanut Co., 5th Cir., 52 F. 2d 4, 8; Huston v. Barrett, 5th Cir., 23 F. 2d 907.

[17]While we recognize that the weight to be accorded the testimony of this witness was primarily for the trial court, we still believe it is an appropriate fact for our consideration in reviewing the trial court's finding of invalidity in what appears to us a close case.

Graham's 798 patent is not invalid, either for "double patenting" or lack of invention, but exhibits patentable novelty and invention not effectively anticipated by any of the prior art patents or alleged public uses relied upon. See *Mumm v. Decker & Sons, 301 U. S. 168, 171; Carnegie Steel Co. v. Cambria Iron Co., 185 U. S. 403; Robertson Rock Bit Co. v. Hughes Tool Co., 5th Cir., 176 F. 2d 783, 790-791; Cline Electric Mfg. Co., et al. v. Kohler, 7th Cir., 27 F. 2d 638, 641; Carson v. American Smelting & Refining Co., 9th Cir., 11 F. 2d 764, 770-772.*

In response to Jeoffroy's intimation in brief that Graham's failure to manufacture commercially the device of his 798 improvement patent shows that he was more interested in extending the scope of his old 811 monopoly than in providing the public with an improved spring clamp device, we can only add that our patent laws have generally acknowledged the validity of the maxim, "prior tempore potior jure," regardless of whether a prospective patentee is guided by altruistic motives, and one who permits others to pre-empt him in securing monopoly protection for patentable devices must necessarily be confined to the struggle for recognition and success amidst the normal forces of competition, unaided by the impetus of a statutory monopoly which rightfully adheres in another.

On the appeal of Jeoffroy Mfg., Inc., the judgment holding claims 5 and 6 Graham's patent No. 2,493,811 infringed by said Jeoffroy Mfg., Inc. is reversed. On the appeal of William T. Graham, the judgment holding the

Graham patent No. 2,627,798 invalid and dismissing the counterclaim as to said patent is reversed. The cause is remanded with directions to enter judgment holding that claims 5 and 6 of Graham's No. 2,493,811 patent are not infringed by the new Jeoffroy structure, but that Graham's No. 2,627,798 improvement patent is valid and infringed thereby, and for further proceedings not inconsistent with this opinion.

REVERSED AND REMANDED WITH DIRECTIONS.

In the

United States Court of Appeals

FOR THE FIFTH CIRCUIT

JUDGMENT

Extract from the Minutes of February 11, 1955

No. 15117

JEOFFROY MFG., INC. *v.* WILLIAM T. GRAHAM,

and

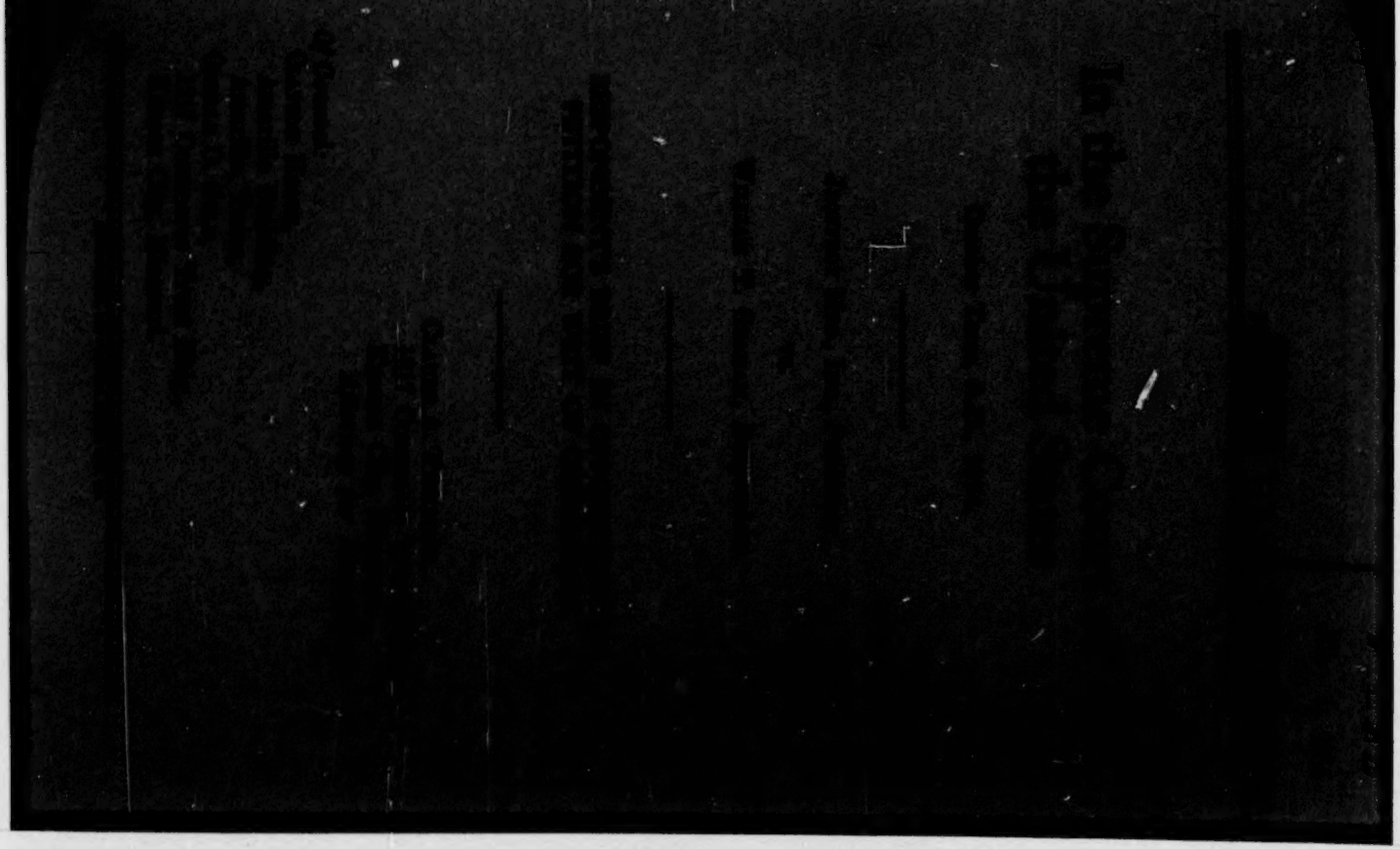
WILLIAM T. GRAHAM *v.* JEOFFROY MFG., INC.

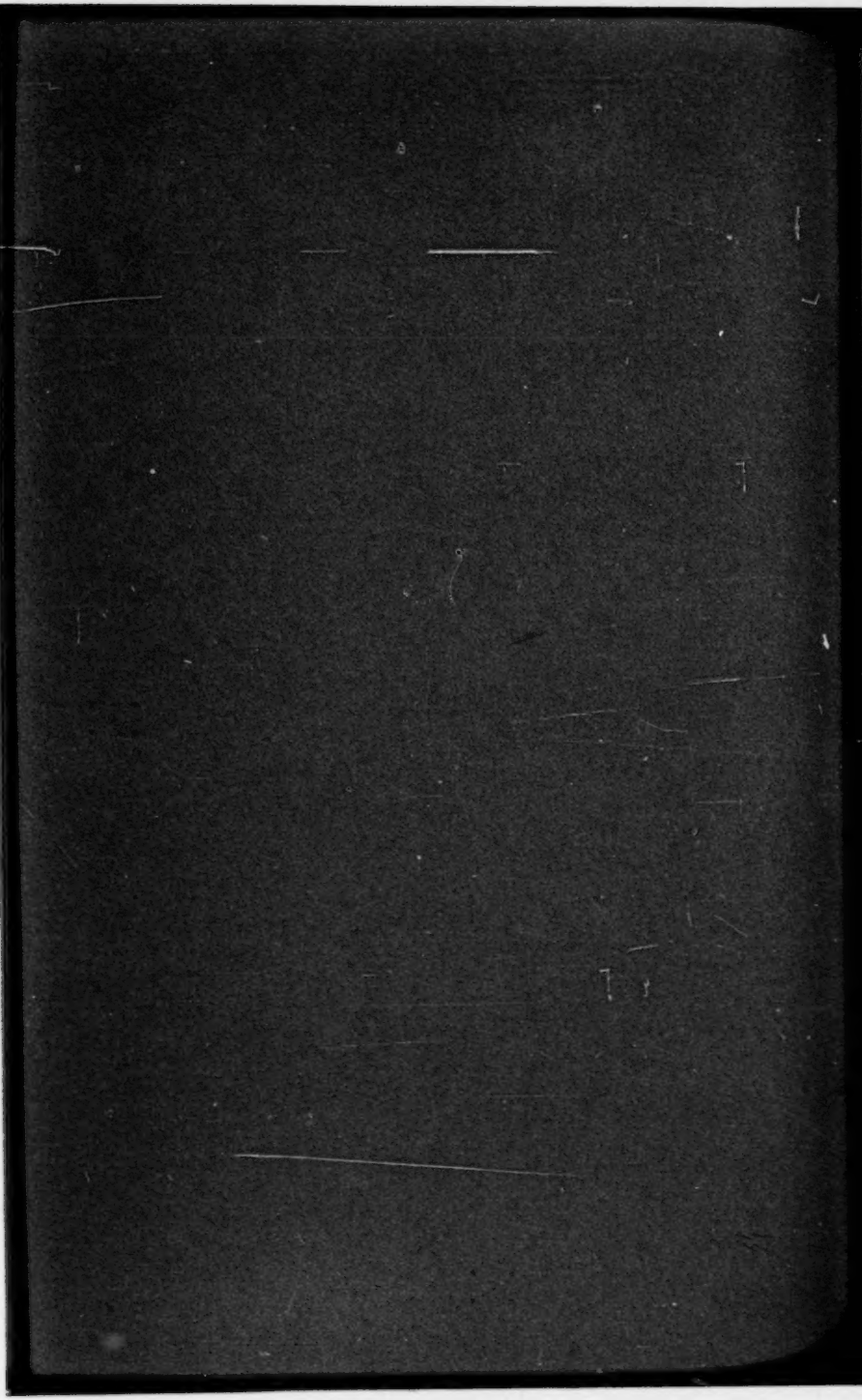
This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Texas, and was argued by counsel;

On consideration whereof, It is now here ordered and adjudged by this Court that the judgment of the said District Court on the appeal of Jeoffroy Mfg., Inc., holding claims 5 and 6 Graham's patent No. 2,493,811 infringed by said Jeoffroy Mfg., Inc., in this cause be, and the same is hereby, reversed; and that the judgment of the said District Court on the appeal of William T. Graham, holding the Graham patent No. 2,627,798 invalid and dismissing the counterclaim as to said patent in this cause be, and

it is hereby, reversed; and that this cause be, and it is hereby, remanded to the said District Court with directions to enter judgment holding that claims 5 and 6 of Graham's No. 2,493,811 patent are not infringed by the new Jeoffroy structure, but that Graham's No. 2,627,798 improvement patent is valid and infringed thereby, and for further proceedings not inconsistent with the opinion of this Court;

It is further ordered and adjudged that the appellee, William T. Graham, be condemned to pay one-half of the costs of this cause in this Court, and that the appellee, Jeoffroy Mfg., Inc., be condemned to pay one-half of the costs of this cause in this Court, for all of which execution may be issued out of the said District Court.





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In the Supreme Court of the United States

October Term, A.D., 1954.

No. 833.

JEOFFROY MFG., INC., *Petitioner,*

vs.

WILLIAM T. GRAHAM, *Respondent.*

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI.

May It Please the Court:

INTRODUCTION.

This is a patent infringement suit brought by petitioner by Declaratory Judgment in the United States District Court for the Northern District of Texas, Amarillo Division, seeking to have respondent's Letters Patent of the United States No. 2,493,811, issued January 10, 1950, for "VIBRATING PLOW AND MOUNTING THEREFOR" (Plt's. Ex. 46, R. 764, Vol. III), declared not infringed, and seeking to have respondent's Letters Patent of the United States No. 2,627,798 issued February 10, 1953, for

"CLAMP FOR VIBRATING SHANK PLOWS" (Plt's. Ex. 46, R. 749, Vol. III), declared invalid and not infringed. Validity of Letters Patent No. 2,493,811 was admitted by petitioner. Respondent answered and filed a counterclaim alleging infringement of both patents by defendant (R. 9, Vol. I).

The District Court, after full and complete hearing, filed its letter-opinion of September 14, 1953, holding Letters Patent No. 2,493,811 infringed (R. 30, Vol. I), and holding Letters Patent No. 2,627,798 invalid, and also holding the petitioner's structure a plain counterpart of Patent 2,627,798 (R. 30, Vol. I).

Petitioner, on October 4, 1953, filed a motion for rehearing and judgment (R. 31, Vol. I), and the court filed a second letter-opinion dated December 18, 1953, on the question of infringement of the first patent No. 2,493,811, again holding such patent infringed (R. 35, Vol. I). Judgment was entered on February 10, 1954 (R. 39, Vol. I).

Petitioner duly filed its appeal to the United States Court of Appeals for the Fifth Circuit from the decision of the District Court holding Letters Patent No. 2,493,811 infringed and respondent duly filed a cross-appeal to the United States Court of Appeals for the Fifth Circuit from the decision of the District Court holding Letters Patent No. 2,627,798 invalid. The Court of Appeals reversed the District Court on both appeals, and rehearing was denied March 9, 1955 (R. 842).

The opinion of the Court of Appeals for the Fifth Circuit for which review is sought appears at R. 818, 828, and is reported in 219 F. 2d, 511, 517.

The petitioner has petitioned for writ of certiorari only as to Patent No. 2,627,798 because the Court of Appeals held such patent valid and infringed.

No Conflict of Decisions.

The Graham Patent No. 2,627,798 issued on February 10, 1953. This is the only time it has been before a Court for adjudication and the only decision that has been rendered upon it. There is no allegation in the petition of conflict of decisions regarding the patent, and in fact, there is none. Under such circumstances, the petition should be denied.

In *Keller* v. *Adams-Campbell Company,* 264 U. S. 314, 68 L. Ed. 705, 708, 44 S. Ct. 356, this Court said:

> "Such an ordinary patent case, with the usual issues of invention, breadth of claims, and non-infringement, this court will not bring here by certiorari unless it be necessary to reconcile decisions of circuit courts of appeal on the same patent."

See also:

Hamilton-Brown Shoe Company v. *Wolf Bros. & Company,* 240 U. S. 251, 60 L. Ed. 629, 633, 36 S. Ct. 269.

Decision Not in Conflict With Established Law.

Petitioners have cited decisions of this Court holding other patents invalid or not infringed, but such decisions were in cases involving facts and circumstances clearly distinguishable from those of the present case. The Court of Appeals for the Fifth Circuit, in deciding the present case, followed other decisions of this Court more pertinent to the facts and circumstances of the present case. Under such circumstances the petition should be denied.

In *Forsyth* v. *Hammond,* 166 U. S. 506, 41 L. Ed. 1095, 1098, 17 S. Ct. 665, this Court said:

> "We reaffirm in this case the propositions heretofore announced, to-wit, that the power of this court

in certiorari extends to every case pending in the circuit courts of appeal, and may be exercised at any time during such pendency, provided the case is one which but for this provision of the statute would be finally determined in that court. And further, that while this power is coextensive with all possible necessities and sufficient to secure to this court a final control over the litigation in all the courts of appeal, it is a power which will be sparingly exercised, and only when the circumstances of the case satisfy us that the importance of the question involved, the necessity of avoiding conflict between two or more courts of appeal, or between courts of appeal and the courts of a state, or some matter affecting the interests of this nation in its internal or external relations, demands such exercise."

The petition will be referred to under headings stated therein.

"C. QUESTIONS PRESENTED FOR REVIEW."

Petitioner has set out three numbered questions apparently as a basis for asking this Court to take jurisdiction of the case on certiorari. The first one relates to the setting aside of the findings of the District Court. The second one merely seeks a review by this Court upon the allegation that the court below erred in applying appropriate standards of invention, and the third because the lower court held the Graham Patent valid without passing upon whether Graham was the sole and original inventor, and if he was whether he had used due diligence in reducing the invention to practice.

The petition involves no special or important questions pertaining to patent law, and merely attacks the court of appeals' holding the second patent No. 2,627,798 valid when the District Court had held it invalid for lack of invention.

Granting of the writ will require a review by this Court of the somewhat voluminous record in existence for the purpose of testing the soundness of the Court of Appeals' decision on which validity of the patent was based, and to do this, the Court must review the whole record including the question of infringement of the first patent No. 2,493,811 which is the subject of a conditional cross-petition by respondent also being filed herein.

"D. STATUTES AND RULES INVOLVED."

Under this heading, petitioner sets out the patent statutes, Sections 101, 102, 103, and Rule 52 of the Federal Rules of Civil Procedure.

Section 103 of the Statute provides that a patent may not be obtained if the difference between the subject matter sought to be patented and the prior art are such that the subject matter *as a whole* would have been obvious at the time the invention was made to a person having ordinary skill in the art to which the subject matter pertains. (Emphasis added.) This matter of obviousness will be referred to later in this brief.

Petitioner challenges the Court of Appeals' right to reverse the District Court's finding of facts and conclusions of law as to Patent No. 2,627,798, but it says nothing about the reversal of such findings and conclusions as to Patent No. 2,493,811 by the same court. This point will also be referred to later in this brief.

"E. STATEMENT OF THE CASE."

Respondent would add to petitioner's statement of the case that the Graham's first patent No. 2,493,811 (R. 764) was directed to a spring clamp for attaching the shank of a ground-working tool to the beam of a plow comprising a fixed member and a movable member pivoted on the fixed member and the forward end of the shank extended between the movable member and the fixed member. The front end of the shank is provided with an opening through which a rod or bolt extends and a coil spring around the rod is seated on the upper part of the bracket or fixed member and held in place by washer and nut. When rearward and upper force is exerted on the ground-working tool during operation, the forward end of the tool shank moves downward against the tension of the coil spring and rocks or pivots with the fulcrum plate of the clamp mechanism so as to enable the tool to pass over an obstruction as well as to add further resiliency to the natural resiliency of the shank. The patent claims refer to pumping action of the ground tool although it is not set forth as a structural element of the claims.

The second Graham patent No. 2,627,798 (R. 749) differs from the first patent primarily in that it places the fulcrum plate above the shank and in addition to the rod extending through the shank and bracket or fixed member, it also has a bolt at the forward end of the shank and fulcrum plate for holding the shank to the fulcrum plate, as well as a stirrup at the back end through which the shank extends. The pivot point for the shank is above the shank instead of below, as in the first patent.

Petitioner in its brief (p. 6) states there were two basic defects in Graham's original patent structure, i.e., a sliding and shifting pivot and the pulling load on the spring rod which produced wear on the rod at the forward part

of the bracket. *These were not basic defects.* The spring clamp covered by the 2,493,811 patent is still in use and the respondent has sold many thousands of plows with these clamps thereon and is still selling many thousands each year.

Like the structure shown and claimed in the Graham patent No. 2,493,811, the improved clamp of patent No. 2,627,798 has a fixed part secured to the lower flange of an H-beam and a movable part pivoted on the fixed part, the movable part being the fulcrum plate. The forward end of the shank is connected to the fulcrum plate at the forward end of said plate, or, in other words, at a substantial distance from the pivot point of the movable part of the clamp. A coil spring is arranged at the forward end of the fixed part and through a nut, washer and spring rod acts on the shank and fulcrum plate to resiliently urge the forward end of the shank and fulcrum plate upwardly toward the fixed part of the clamp, so that when forces are exerted backwardly and upwardly on the ground-working tool the forward end of the shank will move downwardly against the tension of the spring and rock or pivot with the movable part of the fulcrum plate of the clamp so the tool on the shank will move over an obstruction and also add resiliency to the natural resiliency of the shank. By the connection of the shank to the forward end of the plate in the manner disclosed in the patent relative to the improved clamp, the flexibility of structure—the reduced shock is obtained, while some of the wear is eliminated. The shank is supported relative to the movable member by a stirrup which is adjacent to the pivot of the movable part. The stirrup supports the shank, but does so in a manner that permits movement of the shank, thereby retaining the flexibility of the structure. It is the particular arrangement of the parts, with the forward end of the shank and fulcrum plate connected to-

gether in a manner that permits movement of the shank relative to the movable member at the stirrup portion thereof, whereby the flexibility is retained with reduced wear, that is important in this improved clamp.

The claims are directed to the specific structure and arrangement of the parts therein that provide this improved result.

Petitioner in its petition (p. 6) refers to a group of prior patents and unpatented devices.

Apparently petitioner placed little reliance on the bulk of the prior art patents as the principal patent mentioned at the trial and in the argument before the Court of Appeals were the Danish patent of Petersen No. 57,391 and the Graham patent No. 2,493,811; however, reference to all of the prior art patents mentioned in petitioner's petition (p. 6) shows that none of such patents shows a fulcrum plate pivotally mounted to a bracket or fixed part which, in turn, is mounted on a support or frame with means for attaching a shank of a ground-working tool either above or below the fulcrum plate.

It is significant to note the Examiner in the Patent Office cited the very patents relied on by petitioner during the prosecution of the claim for patent No. 2,627,798 (R. 732).

The **Petersen** (Danish) patent No. 57,391 (R. 771-9) is designated a horse hoe. There is a shank of a toothed member secured to the pivoted member by a set screw located adjacent to the pivot point of the pivoted member. The specification explains that this arrangement permits the vertical adjustment of the shank, somewhat similar to the alleged Heldfeld and McKee structures. Petitioner's expert, Witherspoon, admitted (R. 568-577) that modifications would have to be made in the Peterson structure to obtain a device that would work substantially the same as either the new Jeoffroy or the new Graham

devices. He has admitted that you cannot read the claims of the Graham patent on the Danish structure (R. 594). Ray Jeoffroy, vice-president of petitioner, admitted a set screw in the stirrup would not work satisfactory to hold the shank (R. 365).

Patented inventions cannot be superseded by the mere introduction of a foreign publication unless the description and drawing contain and exhibit a substantial representation of the patented improvement in such full, clear and exact terms as to enable any person skilled in the art to make, construct and practice the invention, without reconstruction (*Seymour* v. *Osborne*, 11 Wall. (78 U. S.) 516, 20 L. Ed. 33; *O. K. Jelks & Son* v. *Tom Huston Peanut Co.*, 5 Cir., 52 F. 2d 4, 7)

The **Drader *et al.*** patent No. 417,775 (R. 757) discloses a cultivator tooth secured to a clip that is pivotally mounted on a pin. The structure is primarily a pivotal mounting of a tooth with a resilient extension and stop arrangement to provide a spring action tending to return the tooth into the ground. There is no fulcrum plate in the Drader device.

The **Pfeifer** patent No. 2,014,451 (R. 760) shows a fastening device for anchoring corrugated or other metal sheeting to a supporting frame. This patent was cited by the examiner in the Patent Office but is not believed pertinent to the claims of the Graham patent.

The **Traeger** (Australian) patent No. 111,910, also cited by the Patent Office examiner (R. 775), shows a cultivator tooth connected by a rivet to a U-shaped bracket which is pivotally mounted on a hinge pin. It must be assumed that the forward portion is secured to a beam or the like in some suitable manner. A pair of springs are sleeved on curved bolts and connected to the forward end of the tine whereby the spring tends to urge the ground-working tool into the ground. The Traeger device is clearly

a mere hinged mounting of the shank and does not show a fulcrum plate at all.

The **Graham** patent No. 2,493,811 was cited by the examiner in the Patent Office but upon distinguishing the second device from such patent as above set out, the claims were allowed.

The patents cited by the examiner are clearly representative of the best art, and the fact that the examiner considered same adds weight to the presumption of validity of the Graham patent No. 2,627,798.

The remaining patents cited by the defendants will not be referred to specifically except to say that none of them show the fulcrum plate which is an essential feature of the Graham patent nor the fulcrum plate pivoted on the fixed part of the clamp to attach to a supporting structure, spring tension means on the forward end of the fulcrum plate and shank to provide tension on the shank to hold the digging point thereof in the ground.

The **Jeoffroy** device (R. 802-3) was not prior to Graham's and was the one held by the District Court to infringe the Graham patent No. 2,493,811 (R. 18). The Jeoffroy device did not come into existence prior to August 27, 1951, the filing date of the application for patent No. 2,627,798.

The **Ulmen** and **Holm**, alleged unpatented devices referred to by petitioner, were correctly disposed of by the District Court (R. 22) wherein it stated they were both reduced to a sort of practice but neither stood the test of time and each became a discarded venture. Neither of these devices had any fulcrum plate. Respondent submits they were nothing more than abandoned experiments (*Deering* v. *Winona Harvester Works*, 155 U. S. 286, 39 L. Ed. 153, 15 S. Ct. 18; *Seymour* v. *Osborne, supra*).

The alleged **Helfeld** device (R. 810-13) never came into being at all, none were made and produced by petitioner.

Drawings were first brought forth in February, 1951, long after the invention of the second Graham patent in suit No. 2,627,798.

The **McKee** device referred to (R. 696) by the petitioner in its brief (p. 6) is not prior art in this case. McKee was instructed by Graham to build a device according to his first invention, and McKee did make a structure but the device was discarded and never tested or put in use. The drawing thereof (R. 696) was made at the time of the trial of the first suit from memory 6 years after the device was supposed to have been made. The District Court (R. 29) referred to it as a "crude and inchoate pencil sketch" and "a fleeting gesture at most."

It was Graham, not the inventors of the prior patents, who brought out the importance of the fulcrum plate and its improved arrangements and the patent in suit should be held valid. (*Diamond Rubber Co.* v. *Consolidated Rubber Tire Co.*, 220 U. S. 428, 55 L. Ed. 527, 31 S. Ct. 444). All of these prior devices were open to use by petitioner but it did not elect to use them, instead it used the plaintiff's invention.

It has long been held by this Court that a prior patent or public use which requires modification to perform the function of, or which was not designed for, adapted to or actually used to produce the result accomplished by the patent assailed, cannot anticipate such patent (*Potts* v. *Creager*, 155 U. S. 597, 39 L. Ed. 275, 278, 15 S. Ct. 194; *Topliff* v. *Topliff*, 145 U. S. 156, 161, 36 L. Ed. 658, 661, 12 S. Ct. 825).

Petitioner in its petition (p. 67) referred to the expert witness, Witherspoon, and his testimony that the improvements of the Graham patent No. 2,267,798 were well within the expected skill and capacity of a workman skilled in the agricultural implement manufacturing art carries little if any weight as held by the Court of Appeals

of the Fifth Circuit. He was admittedly not familiar with this art; he was not familiar with patents (R. 532). The only time he saw one of the plows operate was a demonstration approximately ten days before he testified (R. 578). The Court of Appeals took this into consideration as one of its points in holding the patent valid when it said that Witherspoon's testimony was considerably weakened by the fact that he was admittedly not a patent expert. While the Court of Appeals recognized the weight to be accorded the testimony was primarily for the District Court, it said it still believed it is an appropriate fact for our consideration in reviewing the District Court's findings of invalidity. (Footnote 17, 219 F. 2d 519.)

It is clear from the reading of the District Court's opinion (R. 30) that he was clearly of the opinion that the second patent was void for double patenting over the first Graham patent. This was the first reason for holding the patent invalid. He also mentions the invalidity for lack of invention, this being within the capacity of a skilled mechanic. There is nothing to indicate that the Trial Court relied on Witherspoon's testimony in arriving at this conclusion.

Petitioner refers to respondent's expert, Fenton, and states that he did not contradict Witherspoon's testimony with respect to mechanical skill (Brief, p. 7). Fenton was not asked as to whether he agreed with Witherspoon on this point, even in view of the fact that petitioner called Fenton as its own witness and cross-examined him at great lengths (R. 626).

Petitioner (p. 7) refers to Graham's date of invention and particularly the drawing dated March 19, 1950, shown in the record, pages 805, 806, Respondent's Exhibits 13 and 14. The drawing was fully identified by the person making the drawing (R. 611) and Graham constructively reduced his invention to practice the following year by

filing his application for patent on August 27, 1951 (R. 704). Petitioner presented nothing at the trial of this case to show a prior invention other than the Helfeld "supposed" structure, drawings of which were first revealed in February, 1951, which were made four years after a Helfeld actual device was supposed to have been made but could not be found.

Petitioner says in its petition (p. 7) that the workability of the Helfeld structure was fully demonstrated by Jeoffroy. How this was demonstrated is not shown. There was a model made for the trial of the second case, but there is nothing in the record to show that Jeoffroy or anyone demonstrated the workability of this device. The record clearly shows that Graham was the first inventor of the device of the patent in suit.

The District Court was not compelled to pass on the question of whether Graham was the first and sole inventor or whether he used due diligence in reducing the invention to practice because there was no evidence produced by the petitioner on this point or indicate in any manner that Graham was not the sole and first inventor.

"F. REASONS FOR THE ALLOWANCE OF THE WRIT."

Petitioner sets out the reasons for allowance of writ and respondent will refer to them in order:

1. Petitioner challenges the right of the Court of Appeals for the Fifth Circuit to review findings of fact by the District Court and stating overruling of the District Court's findings is in conflict with various decisions of this Court. Some of these cases will be referred to.

In the *United States* v. *United States Gypsum Co.* case, 333 U. S. 364, 395, 92 L. Ed. 746, 766, 68 S. Ct. 525, this Court said that it may reverse findings of fact by a Trial Court where "clearly erroneous" (l. c. 766). This Court

referred to the leading questions of the examiner of witnesses in that case, and it will be observed that counsel for petitioner in this present case was practically testifying himself throughout the examination of his expert witness, Witherspoon. This Court went on to say in the Gypsum case, "Despite the opportunity of the Trial Court to appraise the credibility of the witness, we cannot under the circumstances of this case rule otherwise than that Finding 118 is clearly erroneous."

In the *United States* v. *Oregon State Medical Society* case, 343 U. S. 326, 332, 339, 96 L. Ed. 978, 984, 988, 72 S. Ct. 690, cited by petitioner, this Court again referred to the Gypsum case and said a finding is clearly erroneous when, although there is evidence to support it, the reviewing court on the entire evidence is left with a definite and firm conviction that a mistake has been committed. Certainly the Court of Appeals for the Fifth Circuit upon reviewing the entire evidence believed the District Court was in error in holding the Graham patent invalid for lack of invention and for double patenting. Of course, Witherspoon's testimony as to mechanical skill (R. 576, 577) invaded the province of the Court.

It might here be stated that the District Court took the view that the accused petitioner's device was an infringement of the first Graham patent No. 2,493,811 under the doctrine of equivalents, and by the same token if the accused device was an infringement of the first patent, then the second patent was invalid for double patenting and lack of invention. If the Court of Appeals is correct in its reversal of the District Court with respect to infringement of the first patent, then it was correct in reversing the District Court in its holding of invalidity of the second patent. If the accused device is not an infringement of the first patent, then the second Graham patent, which is a plain counterpart of the accused device, would certainly

have to be held valid because it is not an equivalent of the first patent.

Petitioner attacks the Court of Appeals' decision because it says it is in conflict with the decision of the Court of Appeals, citing various cases. In the *B. F. Sturtevant Co.* v. *Massachusetts Hair & Felt Co.* case, 122 F. 2d 900, 906-908, the Court of Appeals for the First Circuit said there was involved a question of the weight of the evidence of an *admitted* expert on the subject of whether the patent in suit was not disclosed or suggested in any of the prior patents cited by the defendant in that case. The Court of Appeals in the Sturtevant case held the question of patentable invention is one of fact. It also held the question of infringement is one of fact (l. c. 906, 914). It is significant to note that in the Sturtevant case the Master, whose findings were approved by the District Court, held one of the patents in the Sturtevant case, the first one, valid and infringed and the second one invalid in view of the first patent. This is a very similar situation to the present case where the District Court held to the same effect. The Court of Apeals in the Sturtevant case reversed the District Court and held both patents in suit valid and infringed.

It is, of course, true that Rule 52 provides the findings of the District Court shall not be set aside unless clearly erroneous. The Court of Appeals in the Fifth Circuit considered this point very carefully as is noted by its opinion (219 F. 2d 519, footnote 17). It is not believed the question of whether or not certain courts in other circuits who have not disturbed the findings of the District Courts have any particular bearing on granting of writ of certiorari in the present case. Each case is to be decided on the facts and law involved.

2. The petitioner says under its second point the Court of Appeals erred in its approach to the standard of inven-

tion as being contrary to the Patent Act of 1952, 35 U. S. C., Sec. 103, and is in conflict with the decision of this Court in the *Great Atlantic & Pacific Tea Co.* v. *Supermarket Equip. Co.*, 340 U. S. 147, 95 L. Ed. 162, 71 S. Ct. 127; *Altoona Publix Theatres* v. *American Tri-Ergon Corp.*, 294 U. S. 477, 79 L. Ed. 1005, 55 S. Ct. 455, as well as decisions in other circuits, citing numerous cases in such circuits.

The Patent Act of 1952 was a mere codification of the previous act, and provided that a patent may be obtained if the differences between the subject matter and the prior art are such that the subject matter as a whole is not obvious to a person having ordinary skill in the art to which the subject matter pertains (see Report No. 1923 submitted by Mr. Bryson from the Committee on the Judiciary).

With respect to the Great Atlantic & Pacific Tea Co. case it would be presumptous to explain this decision to this Honorable Court, but respondent would call attention to the court's holding that it did not close the door to invention. Such decision is in accord with the Patent Act which says that if the subject matter as a whole is not obvious to a person having ordinary skill in the art to which the subject matter pertains, there is invention. In the A & P case, this Court said we do not mean to go so far as to say that invention never can reside in mere change of dimensions of an old device.

In the present case Graham made substantial changes in his second device over his first patent. In this connection respondent calls attention to the admissions by counsel for petitioner at the trial of this case (R. 52, 53).

"The Court:

Wait a minute. What I asked (maybe I wasn't clear about it), I wanted you to tell me just how you

differentiate the present Jeoffroy structure from the Jeoffroy structure before the Court in the other trial. Mr. Morris:

Oh, it's a completely rearranged structure, Your Honor; the parts are different. The method of mounting is different. The nib-and-socket arrangement, which the Court will recall in the previous lawsuit, is no longer used.

The plate and the shank are bolted firmly together. The plate is mounted above the shank. There is a bracket or box or yoke, sleeve (whatever you might call it) to hold the shank in position.

Those are the primary distinctions.

There is no dual pivot point plus a pivot point on the pivot pin. There is a single pivot carried by a single pivot pin.

There is no longitudinal movement of any sort, either by way of the manufacturing tolerance or otherwise in the device.

I think it's quite clear that the new device is a different device from the other." • • •

"I might say, Your Honor, that the same distinctions of the Jeoffroy present structure over the structure which was involved in the previous lawsuit accord in a fair degree of similarity to the distinctions between the new Graham patent as compared to the old Graham patent."

Here is an admission by counsel for petitioner that Graham, the patentee, made great changes in his second device over that disclosed in his first patent. The accused, petitioner's, device is identical with the second patent in suit. It is a plain counterpart, as held by both courts and admitted by petitioner. When petitioner's counsel was referring to the differences in the petitioner's device he was, in fact, talking about the second patent in suit and the great differences between it and the first device which was held to be an infringement of the first Graham patent.

Respondents will not attempt to refer to the great number of cases referred to by petitioner as showing holdings in the different circuits. It is sufficient to say that each case involves a different set of facts and each is to be decided upon such facts.

3. Under this point the petitioner states (p. 10) that the Court of Appeals has so far departed from the accepted and usual course of judicial proceedings in determining the material facts, questions and issue and not determined by the District Court that this Court should exercise its power of supervision. Respondent submits that, even though the petitioner has not here set out what questions and issues were not determined by the District Court, which were passed on by the Court of Appeals, such a statement is not supported by the record.

The Court of Appeals having rendered a previous decision on the Graham Patent No. 2,493,811 (206 F. 2d 772), and having also previously held one of respondent's patents invalid relating to a brace clamp for the same type of plow as involved in the present case (206 F. 2d 769), it was very careful to consider all of the facts and questions and to determine the rights of the parties as the record before it indicated.

"G. ARGUMENT AMPLIFYING REASONS."

1. Under this point petitioner again argues that the Court of Appeals erred in overruling the findings of the District Court, citing various cases. The United States Gypsum case has heretofore been referred to. The Yellow Cab case merely stated that this Court saw no error in the findings of the lower court.

In the Graver Tank case (336 U. S. 271, 274, 279, 93 L. Ed. 672), this Court said that a case where expert testimony was involved or testimony by experts in which the

Trial Court may be enlightened by scientific demonstrations, the findings are entitled to great weight. However, in the present case the witness Witherspoon was admittedly not an expert. The record is clear that the District Court did not hold the patent in suit invalid for lack of invention on this witness' testimony alone. In fact, the patent was held invalid in the first instance for double patenting. It is significant to note that at first counsel for petitioner relied on the question on double patenting but later candidly admitted to the Court of Appeals (219 F. 2d 518) that the Trial Court was clearly wrong in concluding that patent 2,627,798 is void as double patenting of the original Graham invention. Petitioner before the Trial Court also admitted this after relying heavily upon the case of *Continental Farm Equip. Co.* v. *Love Tractor*, 199 F. 2d 202, and admitted this case was not in point.

Petitioner attacks the Court of Appeals' decision (p. 11) in that it did not conclude the District Court's finding was clearly wrong, or it was convinced a mistake had been made. It was not necessary that the court spell out its holding in this identical language. The petitioner did not quote all of the Court of Appeals' holding. What the Court of Appeals said was (219 F. 2d 518):

> "Our interpretation of the prior art, the physical exhibits, and the testimony, however, compels us to disagree with the learned District Court's conclusion that the 798 patent is invalid, either for 'double Patenting' or for lack of invention."

The petitioner (p. 11) secondly attacks the opinion of the Court of Appeals as showing upon its face that said court sought to try the case *de novo* upon the record. Such an argument is not supported by the decision of the Court of Appeals. Of course, the Court of Appeals

thoroughly considered all aspects of the case as is clearly shown in its opinion (219 F. 2d 519), wherein, after pointing out the advantages of the new structure of the new device shown in the second Graham patent over the device shown in the first Graham patent, the court said other factors strongly influencing and reinforcing our conclusion as to validity of the 798 patent are:

(1) Presumption of validity;
(2) Proof of invalidity is on the party seeking to upset a patent's prima facie validity, and any reasonable doubt will be resolved against him;
(3) That an improvement combination is patentable even though its constituent elements are clearly revealed by the prior art where as here, it produces an old result in a cheaper and more advantageous way;
(4) The Trial Court's findings and Jeoffroy's significant admissions as to the improved efficiency and economy in the 798 structure as well as the lack of disclosure thereof by any single device or group of devices in the prior art;
(5) The fact that Jeoffroy himself apparently considered the 798 structure independently patentable over 811 and the prior art as evidenced by his filing of an application for a patent on its counterpart and subsequent withdrawel thereof only when Graham's 798 patent was issued first;
(6) The force which might otherwise attach to the eminent Trial Court's conclusion as to invalidity, insofar as based on testimony by Jeoffroy's witness Witherspoon that the improvements embodied in the 798 were within the capacity of an ordinary skilled mechanic, being considerably weakened by the fact that this witness was not a patent expert.

Respondent respectfully submits that the Court of Appeals gave very great care to all points involved in this

case and decided the issues as to the 2,627,798 patent in accordance with the weight of the evidence and in accordance with the rules laid down by this and other courts as to the question of invention.

Thirdly, the petitioner (p. 11) attacks the Court of Appeals' holding in setting aside the District Court's findings because it classified the case as "close." The Court of Appeals was convinced that the District Court was clearly in error in weighing the evidence and in its holding of invalidity of the patent. The Court of Appeals merely followed its duty in what it found to be clearly an error by the District Court.

The petitioner says under its fourth point (p. 11) that the Court of Appeals usurped the District Court's function in determining the credibility of witness and disregarded the testimony of Jeoffroy's expert witness because he was only a qualified engineer and not "a professional patent testifier." This point has heretofore been referred to and will not be repeated.

2. Under this point the petitioner states (p. 12) of equal importance is the need for review of the obviously improper approach to the standard of invention as controlled by the Patent Act of 1952. The Patent Act did not change the existing law and the courts have so held. Respondent urges that the Court of Appeals for the Fifth Circuit did not apply a different standard of invention than set out in the Act and as stated in the A & P case.

The petitioner attacks the Court of Appeals' opinion as being in accord with its own prior decisions following the old approach of *Parks* v. *Booth*, 12 Otto 96, 102 U. S. 96, 104, 26 L. Ed. 54, that novelty and invention in a combination patent cannot be negatived by the prior art unless the combination is disclosed by a single prior art patent. This is a misstatement in regard to the Court of Appeals' opinion. It cited the *Parks* v. *Booth* case with reference

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to prior art, but it also said (219 F. 2d 519) that an improvement combination is patentable *even though its constituent elements are singly revealed by the prior art* (emphasis added), here clearly indicating that it considered various elements as found in different prior art patents or public uses. We cannot agree with the petitioner's argument that the A & P case or the Altoona Publix Theatres case overruled the Court's holding that an improvement combination is patentable even though its constituent elements are singly revealed by the prior art where, as here, it produces an old result in a cheaper and otherwise more advantageous way.

The fact of the matter is none of the prior art patents and alleged uses taught the invention of the patent in suit in a way that would be obvious to a person skilled in this art to produce the invention of the patent in suit. It must not be overlooked that Jeoffroy himself thought this was invention because he filed an application for patent on this device claiming it was invention and made oath that it had not been known to others or in public use for more than one year prior to the filing of his application for patent. The Court of Appeals mentioned this point, in holding the structure involved invention and the patent valid. In other words, the Court of Appeals held that the subject matter as a whole was not obvious to a person having ordinary skill in the art to which the subject matter pertains.

The holding of the Court of Appeals that a combination is patentable even though its constituent elements are singly revealed by the prior art to produce an old result in a cheaper and otherwise more advantageous way is not a rule followed only by the Fifth Circuit. It is followed by the Tenth Circuit (*Independent Oil Well Cementing Co.* v. *Halliburton*, 54 F. 2d 900, 905); it is followed by the Eighth Circuit (*Galvin Electric Mfg. Co.* v. *Emerson Elec-*

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tric Mfg. Co., 19 F. 2d 885, 888) and other circuits, and it has been followed by the Supreme Court (*Grinnel Washing Machine Co.* v. *E. E. Johnson Co.*, 247 U. S. 426, 432, 62 L. Ed. 1196, 38 S. Ct. 547, *Hailes* v. *Van Wormer*, 20 Wall. (87 U. S.) 353, 368, 22 L. Ed. 241; *Seymour* v. *Osborne, supra; Webster Loom Co.* v. *Higgins*, 105 U. S. 580, 26 L. Ed. 1177; *Barbed Wire Patents Case*, 143 U. S. 275, 36 L. Ed. 154, 12 S. Ct., 443; *Expanded Metal Co.* v. *Bradford*, 214 U. S. 366, 53 U. S. 1034, 29 S. Ct. 652; *Smith* v. *Snow*, 294 U. S. 1, 79 L. Ed. 721, 55 S. Ct. 279).

Petitioner (p. 14) quotes from the A & P case where it held, "Courts should scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." The Court of Appeals for the Fifth Circuit referred to the A & P case in its opinion (219 F. 2d 518) and this is an indication that the Court of Appeals for the Fifth Circuit is at all times mindful of the decision of the A & P case. The Court of Appeals cited other decisions of that court as following the A & P case, and there is no indication that it did not follow the A & P case in deciding the present case.

The invention disclosed in the Graham patent 2,627,798 was found by the Court of Appeals for the Fifth Circuit to include elements or at least elements located and operating in a different manner than the prior art. It is submitted therefore that the Court of Appeals' decision is not out of tune with every single one of the decisions from other circuits as alleged by the petitioner, nor is it out of tune with the decisions of this Court.

3. The petitioner says the third ground alone is sufficient for this Court to exercise its reviewing power, because the District Court did not decide whether Graham was the sole and original inventor. In one breath the peti-

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tioner praises the District Court's findings and conclusions and in the next breath it says this Court should take jurisdiction of the case because the District Court erred.

On the question of sole and original inventor, petitioner states these issues were not considered by the District Court. The District Court considered all the prior alleged uses. It apparently did not think petitioner's evidence on this point was sufficient to mention in detail.

The petitioner says the Court of Appeals tried those issues *de novo* on the record and clearly usurped the District Court's function. The Court of Appeals did not consider from the record that there was sufficient evidence to overthrow the presumption of validity attaching to the Graham patent in suit. There was no error by the Court of Appeals for the Fifth Circuit in so holding.

The Opinion of the Court of Appeals of the Fifth Circuit.

The opinion of the Court of Appeals of the Fifth Circuit (219 F. 2d 511) shows that the court gave this case unusually careful attention in view of the fact that the parties had been before the court theretofore on one of the patents involved in this suit (No. 2,493,811, the first Graham spring clamp patent).

The Court of Appeals reviewed its former opinion relating to patent No. 2,493,811 (reported in 206 F. 2d 772) which is indicated by the language of the opinion (219 F. 2d 515).

Respondent submits that in view of the Court of Appeals finding that the accused Jeoffroy structure did not infringe patent No. 2,493,811, it was proper to hold the second patent No. 2,627,798 valid as an improvement over the first one.

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The Court of Appeals opinion (219 F. 2d 517) sets out the points conceded by Jeoffroy to be new in the Graham patent under four specific points. It is pointed out (219 F. 2d 518) that Jeoffroy's accused structure cannot be distinguished from patent No. 2,627,798; that the Trial Court was clearly wrong in concluding the said patent was void for double patenting; that no single prior reference patent or structure anticipates the claims of the patent, nor will the claims read on any one of the references, and finally that "unquestionably Graham's new patent structure is a definite improvement over the old."

The court carefully considered the prior art (219 F. 2d 518) and finally concluded that it disagreed with the learned District Court's conclusion that the patent is invalid either for double patenting or for lack of invention. However, as an improvement patent it is not entitled to any broad degree of protection over Graham's first patent No. 2,493,811. It is respectfully submitted, therefore, that the Court of Appeals' decision on the question of validity of patent No. 2,627,798 is sound and should be adhered to. Its findings and conclusions are fully supported by the record and it is clear that the Court considered all of the record, and even its prior opinion and argument of counsel with respect to the first patent No. 2,493,811.

CONCLUSION.

In conclusion it is respectfully submitted the petition for writ of certiorari asserts no grounds upon which the writ should be granted. The Court of Appeals for the Fifth Circuit carefully considered the decision of the Trial Court on all phases and the decision of this Court

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in the A & P case in holding the Graham patent No. 2,627,798 valid. Denial of the petition is respectfully requested.

Respectfully submitted,

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Certificate of Service.

Two copies of the foregoing Respondent's Brief in Opposition to Petition for Writ of Certiorari have been sent by United States mail, postage prepaid, to W. W. Gibson and S. Tom Morris, 630 Amarillo Building, Amarillo, Texas, Attorneys for Petitioners, this 25 day of June, 1955.

Attorney for Respondents.

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No. 113

In the

Supreme Court of the United States

OCTOBER TERM, 1955

JEOFFROY MFG., INC.,
Petitioner,

v.

WILLIAM T. GRAHAM,
Respondent.

PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

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Respondent.

PETITION FOR REHEARING AFTER DENIAL OF CERTIORARI

To the United States Supreme Court:

Petitioner, JEOFFROY MFG., INC., respectfully prays for a rehearing and reversal of the order entered on October 10, 1955, denying its petition for writ of certiorari to the United States Court of Appeals for the Fifth Circuit, and as grounds therefor shows the following:

1. Intervening Circumstances of Substantial Effect

By way of review—the patent in suit, No. 2,627,798, covers an improved spring clamp for a plow. The District

Court found as a matter of fact that the improvements covered by the patent were "well within the capacity of a skilled mechanic" (R. 31), and held the patent void for lack of invention. The Court of Appeals overturned the trial court's finding, concluding that the

> "* * * hybrid type structure combining the wear-resisting rotating pivot, in part reminiscent of the prior art, with the new shank and stirrup arrangement permitting some of that same advantageous flexibility inherent in the old * * * structure, reveals sufficient indicia of novelty and invention to justify limited protection"

and reversed the judgment.

In the petition for certiorari we urged that the Court of Appeals completely disregarded Rule 52(a) of the Federal Rules of Civil Procedure requiring that:

> "Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses."

The Court of Appeals did not expressly state that it was disregarding Rule 52(a), but that it did so is obvious upon the face of the opinion. It can only be concluded from the opinion that the Court of Appeals considered the questions of novelty and invention as questions of law, fully reviewable by it de novo upon the record without regard to the trial court's findings of fact.

Our interpretation of the opinion is fully borne out by a subsequent decision of the Fifth Circuit to which we now

direct the Court's attention as an intervening circumstance of substantial effect. On July 15, 1955, some forty-five days after the Petition for writ of certiorari was filed herein, the Court of Appeals handed down its decision in *Fritz W. Glitsch & Sons v. Wyatt Metal & Boiler Works, 224 F. 2d 331*, in which the Court said at page 335:

> "* * * while infringement is usually a question of fact, on which the normal presumption of verity might attach to the findings of the trial court under Rule 52 (a), F. R. C. P., the issue of whether a particular patent meets the requisite standard of invention essential to validity is now generally regarded as a fully reviewable question of law * * *."

The Court then proceeded to determine the question of invention de novo upon the record without regard to or discussion of the trial court's findings.

We express no opinion as to the *result* of the *Glitsch* case. Our point is that the Fifth Circuit has now made it absolutely clear that it considers Rule 52(a) wholly inapplicable to the review of the trial court's findings upon invention, and the conclusion is inescapable that its rulings in the case at bar were guided and controlled by that view of the law.

It is thus clear beyond any question that the case at bar is in direct conflict with *Graver Tank & Mfg. Co. v. Linde Air Prod. Co., 336 U. S. 271 (1949)*, wherein the Court said that in no type of case is it more appropriate to give due regard to the trial court's opportunity to judge credi-

bility of the witnesses than in a patent case, and at page 279 that:

> "The same deference is due to the findings of the trial court which overturn claims as to those which sustain them. Technicians may and probably will continue to debate with plausible arguments on each side as to what this obscure process really is. But the record in this case, while not establishing to a certainty that the findings are right, fall far short of convincing us that they are clearly erroneous. We think that the rules that govern review entitle the trial court's conclusions to prevail and that the process claims are invalid under the statute."

The *Graver Tank* decision has not been in any manner disturbed by *Great A & P Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147 (1950)*, and if the Court meant what it said in the *Graver Tank* case then the Fifth Circuit decision in the case at bar is clearly wrong.

It may be agreed that the ultimate question of patentability, including the question of whether an appropriate standard was applied, is one of law fully reviewable by the appellate courts, but that does not mean, as the Fifth Circuit seems to think, that Rule 52(a) is wholly inapplicable where the question of invention is involved. In the case at bar the trial court made a pure finding of fact that the improvements covered by the patent were "well within the capacity of a skilled mechanic." The Fifth Circuit did not hold or even intimate that the trial court applied an inappropriate standard; it merely disagreed with the trial court's finding and thereupon reversed the decision.

It is thus apparent that the Court of Appeals applied an erroneous rule of law as to the scope of review, and a question of law is clearly presented which calls for review by this Court.

II. Substantial Grounds not Previously Presented

The decision of the Court of Appeals is in conflict with the decision of this Court in *Lincoln Engineering Co. v. Stewart-Warner Corp., 303 U. S. 545 (1938); General Electric Co. v. Wabash Appliance Corp., 304 U. S. 364 (1938); United Carbon Co. v. Binney & Smith Co., 317 U. S. 228 (1942);* and *Great A & P Tea Co. v. Supermarket Equip. Corp., 340 U. S. 147 (1950);* for a reason not heretofore presented to this Court.

The cited cases hold that invention which is not particularly pointed out and distinctly claimed in the patent cannot support the patent, yet the Court of Appeals has here sustained the patent by finding invention which was not pointed out, claimed, otherwise disclosed or even hinted at in the patent. The Court of Appeals said *(219 F. 2d 518,* and at page 16 of the appendix to our petition for certiorari):

> "Though we do agree that 798 (Patent No. 2,627,798), as an improvement combination, is not entitled to any broad degree of protection over 811 (Patent No. 2,493,811), it still seems to us that its hybrid type of structure combining the wear-resisting rotating pivot, in part reminescent of the prior art, with the new shank and stirrup arrangement permitting some of the same advantageous flexibility inherent in the old

> 811 structure, reveals sufficient indicia of novelty and invention to justify limited protection."

This theory of invention upon which the Court of Appeals has lodged is not mentioned or claimed in any respect in the patent. It is the mere afterthought contention of patentee's counsel which the Court of Appeals has accepted as sufficient to support the patent.

A holding of patentability upon supposed invention not disclosed or claimed in the patent was squarely condemned by this Court in the *A & P* case, *340 U. S. at 149*, as follows:

> "Since the Courts below perceive invention only in an extension of the counter, we must first determine whether they were right in so doing. We think not. *In the first place, the extension is not mentioned in the claims*, except, perhaps, by a construction too strained to be consistent with the clarity required of claims which define the boundary of a patent monopoly." (Italics supplied.)

A similar attempt to support a patent upon a theory of invention not pointed out or claimed in the patent was equally disapproved in the *Lincoln Engineering* case, *303 U. S. at 549*, as follows:

> "* * * the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in a new combination. Though the respondent so concedes, it urges that, in the combination of the Butler patent, the headed nipple performs a new and different function from that which it has heretofore performed, in other combinations, in that, when

> the coupler is withdrawn from the nipple, at the end of the greasing operation, the round head of the nipple 'cocks' the jaws of the coupler for the next operation. *The sugges ion seems to be an afterthought. No such function of the nipple is hinted at in the specifications of the patent.* If this were so vital an element in the functioning of the apparatus it is strange that all mention of it was omitted." (Italics supplied.)

In the patent in suit there is no hint of a hybrid type structure combining the rotating pivot of the prior art to reduce wear with a stirrup and shank arrangement *to retain some of the desirable flexibility* of the old Graham 811 structure. On the contrary, the specifications speak of a shank *rigidly secured* to a shank attaching member and the claims call for a shank in *constant and continuous* contact with a shank attaching member. ~~But~~ thus, even assuming that the Court of Appeals was correct in concluding that there was invention (a matter which we have pointed out in our petition for certiorari as being based on an erroneous standard of "old result in a cheaper and otherwise more advantageous way"), such invention clearly cannot support the patent because it was not pointed out or claimed therein.

It seems clear to us that the Fifth Circuit has sustained the patent on grounds squarely in conflict with decisions of this Court and for this reason also writ of certiorari should be granted.

III. Importance of the Case

It is inconceivable that this Court could have denied the petition for writ of certiorari on the ground that no ques-

tion is presented appropriate for its review. It must be that the Court considers the matter too trivial to take a place on the docket, and we, therefore, earnestly urge that the Court reconsider the importance of the case in the light of the following additional circumstances.

We recognize that the decision will not touch the lives of all citizens as would a segregation, anti-trust, or tidelands decision, but, even so, there is much more at stake here than the mere final result to these litigants. The erroneous rules and concepts under which the Fifth Circuit is deciding patent cases affect every person who must have his rights or liabilities under any patent adjudicated in this Circuit, and with the rapidly expanding industrialization of the Southwest the number of such persons is daily increasing by leaps and bounds. Furthermore the whole public is affected by every patent monopoly that is either sustained or struck down. There is also another aspect of considerable importance. The pro-patent attitude of the Fifth Circuit is so well known that it is breeding patent litigation here which would otherwise go elsewhere or not be filed at all. For instance, there is now pending in the United States District Court for the Northern District of Texas, Amarillo Division, another suit, No. 1953, styled *William T. Graham, et al. v. Cockshutt Farm Equipment, Inc.*, under this same patent against a defendant whose main office is in Ohio, and who has only a dealer in this district. Another example is No. 1992 in the same Court, styled *Carl A. Hillgren v. Amarillo Lumber Company, Inc., et al.*, wherein a California patentee, whose patent

has been struck down by the Ninth Circuit in *Kwikset Locks v. Hillgren, 210 F. 2d 483 (1954)*, is suing a Texas retailer on a lock made by an Illinois manufacturer. One may wonder why the suit was not brought directly against the manufacturer in Illinois, and the quick and ready answer would seem to be that the patentee hopes to obtain a decision of validity in the pro-patent Fifth Circuit contrary to that of the Ninth Circuit, and thus advance to the Supreme Court.

These considerations strongly indicate that this Court should grant a rehearing and upon rehearing grant a writ of certiorari not only to correct an erroneous result between these litigants but also to correct the erroneous rules and concepts prevailing in the Fifth Circuit.

WHEREFORE, Jeoffroy Mfg., Inc., prays that this petition for rehearing be granted and that upon further rehearing it have relief as prayed for in the original petition for writ of certiorari.

Respectfully submitted,

W. W. GIBSON and
S. TOM MORRIS,
630 Amarillo Building,
Amarillo, Texas,
Attorneys for Petitioner.

By W. W. GIBSON

CERTIFICATE OF COUNSEL

I hereby certify that this petition for rehearing is presented in good faith and not for delay, that it is limited to the grounds above specified as provided by Rule 58 (2) of the Rules of the Supreme Court, and that copies of this petition have been delivered in person to Clayton Heare, Amarillo Building, Amarillo, Texas, and sent by United States Mail, postage prepaid, to Claude A. Fishburn and Orville O. Gold, 1217 Commerce Trust Building, Kansas City, Missouri, attorneys for Respondents.

DATED: October 31, 1955.

W. W. GIBSON

Attorney for Petitioner.